

obviousness-type double patenting; 3) rejected claims 1-102 under U.S.C. § 112, second paragraph; and 4) rejected claims 1-102 under 35 U.S.C. § 103 (a).

II. Priority

The Examiner noted that a claim for priority is unperfected until Applicant files an English language translation of the foreign priority document. Applicant respectfully disagrees, since 37 C.F.R. 1.55 specifically states that a translation is not required. More specifically, Rule 55(a) states:

If the certified copy is not in the English language, a translation need not be filed except in the case of interference; or when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner, in which event an English language translation must be filed together with a statement that the translation of the certified copy is accurate.

To Applicant's knowledge, this application is currently not involved in any interference proceeding. Further, this date is not currently being relied upon to overcome the date of a reference relied upon by the Examiner. Withdrawal of this requirement is respectfully requested.

III. Double Patenting Rejections

Claims 1-102 have been rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-3, 6, 9 and 23-32 of prior U.S. Patent No. 6,056,945. Applicant respectfully traverses this rejection.

The Examiner's attention is directed to claim 1 of the present application, and to the fact that no claim in the patent is directed to the same invention as claim 1. For

example, the Examiner may note that claim 1 of the present application requires, for example, "at least one nonionic polymer comprising at least one vinyllactum unit . . ." The Examiner may then note that claim 1 of the patent, the broadest claim therein, does not contain that limitation. As a result, the statutory double patenting rejection is improper, and Applicant requests that it be withdrawn.

If the Examiner persists in maintaining this rejection, then rather than broadly referring to claims 1-3, 6, 9 and 23-32 of the patent, the Examiner is respectfully requested to specifically identify which claims of the pending application are identical to which claims of the patent. Applicant submits that such an analysis will show that no statutory double patenting rejection can be maintained.

Claims 1-102 were "provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33, 36-37, 47-59 of copending Application No. 09662804; over claims 1-76; 1-37, 78-112 of pending Application No. 09662796; over claims 152-164 of pending Application No. 09663168; over claims 1-39, 42, 72-81, 83-85 of pending Application No. 09664402; and over claims 1-32, 51-60 of pending Application No. 09664402." See Office Action at page 3.

It is unclear, however, which claims were provisionally rejected over pending Application No. 09662796 (i.e., claims 1-76 or 1-37 and 78-112). See above and Office Action at page 3, paragraph 3: "Applicant respectfully requests that the Examiner clarify the rejection. Applicant also requests that the Patent Office hold the rejection in abeyance until allowable subject matter is indicated."

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005
202-408-4000

IV. Rejection under 35 U.S.C. 112

Claims 1-102 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

First, according to the Office Action, "claims 3-27, 30, 35, 37, 46, 48, 52-76, 79, 84, 86, 95 and 97" were rejected "for use of improper Markush groups." See Office Action at page 4, section (i). Applicant respectfully disagrees with the Office that the language of these claims is indefinite, and therefore traverses this rejection.

The phrase "X is chosen from A, B, and C" is proper language and accurately describes the claimed invention, *i.e.*, the composition may contain one or more X with each X independently selected from the group A, B, and C. For example, both Applicant's claim language and the examples the Office points to in M.P.E.P. § 2173.05(h) cover a composition of the invention that may contain: A; A and B; or two A's, two B's and a C, as well as all other permutations. However, Applicant's claim language is clearer, and the Office has shown no legal basis for requiring Applicant to change it.

The Examiner relies on M.P.E.P. § 2173.05(h) for a discussion of proper alternative claim language. However, § 2173.05(h) merely recites examples of proper claim language, which may be representative but are not exclusive. In fact, the U.S. Patent and Trademark Office (PTO) has provided other representative examples of proper alternative claim language. Specifically, Applicant directs the Examiner to another example of proper alternative claim language is set forth in the M.P.E.P:

"wherein R1 is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S)."

See M.P.E.P. Appendix AI (PCT), Example 20, p. AI-44 of the July 1998 edition.

The PTO has also published model claims utilizing other claim language, i.e., X selected from A, B, and C, in the *Training Materials For Examining Patent Applications with Respect to 35 U.S.C. Section 112, First Paragraph - Enablement Chemical/Biotechnical Applications*, released August, 1996. The PTO training materials further clarify that "X selected from A, B, and C" is proper claim language. Following the background case law, training materials, and discussion regarding enablement, the PTO provides Examiners with several example specifications, claims, and model rejections and analysis. See *Training Materials For Examining Patent Applications with Respect to 35 U.S.C. Section 112, First Paragraph - Enablement Chemical/Biotechnical Applications*, at Enablement Decision Tree, August, 1996. The Examples provided demonstrate what the PTO considers to be proper claim language. Example H, entitled "Endothelin Receptor Antagonists" provides a model claim with claim language that reads "at least one hetero atom selected from N, S, and O," while Example J, entitled "Selectin-Mediated Cellular Adhesion" provides a model claim with claim language that reads "wherein the substituent is selected from halogen, C₁₋₄ alkyl, trifluoromethyl, hydroxy, and C₁₋₄ alkoxy."

In light of the additional examples of proper alternative claim language provided by the PTO, it is clear that there is no reason for the Office to require Applicant to change the claim language of the pending claims. Accordingly, Applicant respectfully submits that this reason for rejection under 35 U.S.C. § 112, second paragraph, is in error, and request that it be withdrawn.

Maintain!

Second, according to the Office Action, the terms "derivative" and "carbon based unsaturated compounds" in claims 1-103 [sic, read "1-102"] are indefinite. See Office Action at page 4, section (ii). The Examiner stated that the terms were "neither disclosed in the specification nor would they be apparent to one of ordinary skill in the art. As a result, the metes and bounds of patent protection desired are unascertainable." *Id.* Applicant respectfully disagrees and traverses this ground of rejection for all of the following reasons.

In order to meet the requirements of 35 U.S.C. § 112, second paragraph, the claims must define the patentable subject matter with a reasonable degree of particularity and precision. See M.P.E.P. § 2173.02. The Federal Circuit has decided that the definiteness of the claim language must be analyzed, not in a vacuum, but in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. See M.P.E.P. § 2173.02.

Accordingly, Applicant submits that the term "derivative" is cited in the instant specification in several places (e.g., see specification page 4, lines 16-18; page 11, lines 2; 20, and 25, etc.). Therefore, the Examiner is incorrect in stating that the term is not disclosed in the specification. Furthermore, Applicant asserts that one of ordinary skill in the art would readily understand the meaning of the term, which rather than being indefinite, is a term of art in the context in which it is used. When properly analyzed in light of the teachings of the content of the specification, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made, the claim

language clearly defines the subject matter that Applicant considers within the scope of the invention with both particularity and precision. The American Heritage College Dictionary (Third Edition) defines the verb "derive" as "4. *Chem.* To produce or obtain (a compound) from another substance by chemical reaction." Accordingly, Applicant respectfully asserts that this language is merely broad, rather than indefinite, and a broad claim is not indefinite for the purposes of § 112, second paragraph, as long as the boundaries of the claim are capable of being understood. M.P.E.P. § 2173.04.

With respect to the phrase "carbon based unsaturated compounds," this limitation can also be found in several places in the instant specification (e.g., see specification page 5, lines 10, 15-16 and 18-19, etc.). Moreover, one of ordinary skill in the art would readily know that "carbon based unsaturated compounds" include, but are not limited to, compounds such as styrene and isoprene. See specification page 5, lines 18-19. Therefore, the metes and bounds of the patent protection desired are ascertainable. Applicant respectfully requests withdrawal of this rejection.

V. Rejection under 35 U.S.C. 103(a)

Claims 1-102 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Blackenburg [Blankenburg] et al. (WO 99/04750) in view of Myers et al. (WO 94/12148). Applicant respectfully traverses this rejection for at least the reasons set forth below.

The Office carries the initial burden of establishing a *prima facie* case of obviousness, and in doing so must establish: (1) that there exists some suggestion or motivation, either in the references themselves or in the knowledge generally available

to one of ordinary skill in the art, to combine reference teachings; (2) that there is a reasonable expectation of success in such a combination; and (3) that the references when combined teach or suggest all limitations of the claim. See M.P.E.P. § 2143. See also *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568 (Fed. Cir. 1996); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Further, the Federal Circuit has stated that the evidence of a teaching, suggestion, or motivation to modify or combine must be "clear and particular." See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Applicant asserts that the Examiner has not established any suggestion or motivation to combine the references. The Examiner, rather, simply rationalizes that "the motivation to do so arises from the fact that (i) the cited analogous art discloses all claimed ingredients; and (ii) Myers et al. specifically teach polyvinyl lactams." See Office Action page 6. This reasoning, however, is improper. "A determination of obviousness must involve more than indiscriminately combining prior art; a motivation or suggestion to combine must exist. See Micro Chem., Inc. v. Great Plains Chem Co., Inc., 103 F.3d 1538, 1546 41 USPQ .2d 1238, 1244 (Fec. Cir. 1997). According to the Examiner, however, "both the motivation and reasonable expectation of achieving a hair formulation that provides body, consistency, firm texture, and maintains the hair in a desired arrangement are found in the prior art cited." See Office Action page 6. Applicant respectfully disagrees. The Examiner has not shown that the references suggest or disclose the claimed invention, and neither has the Examiner proven any motivation to combine the references with a reasonable expectation of success.

Importantly, Blankenburg is not even concerned with a composition that comprises at least one nonionic polymer that includes at least one vinyllactam unit. Rather, Blankenburg teaches the use of water-soluble or water dispersible polymers that are accessible by radical polymerization (e.g., see translated copy at page 3). The polymers may include ethylenically unsaturated monomers in the presence of silicone derivatives, and other polymers may be added to the polymer preparations after polymerization. See translated copy at pages 4-10. Further, at Examples 21 and 22, Blankenburg teaches a mixture of vinylcaprolactam (a vinyllactam) with dimethicone. However, there is no such disclosure in any of the examples of a composition that comprises both (a) at least one silicone/acrylate copolymer and (b) at least one nonionic polymer comprising at least one vinyllactam unit. See instant claim 1.

Moreover, Myers does not cure the deficient teachings of Blankenburg. In fact, Applicant cannot find anywhere in Myers where the use of polymers that include ethylenically unsaturated monomers in the presence of silicone derivatives, as taught by Blankenburg, is disclosed. While Myers teaches hair spray formulations that primarily consist of sulfo-polyesters with added quantities of polyvinyl lactam polymers (e.g., see pages 5-9, "Description of the Invention"), Myers does not teach or suggest the usage of polyvinyl lactam polymers with all types of hair spray formulations. Rather, Myers teaches the use of these polymers with compositions that consist of sulfo-polyesters, which is completely different from the composition of Blankenburg. See pages 10-15, Examples I-VIII. Thus, one of ordinary skill in the art would not be motivated to combine Myers and Blankenburg, since they are directed to very different compositions and

teach away from the present invention. Furthermore, the suggestion to combine the references to achieve Applicant's invention cannot exist.

Since the Examiner has not satisfied any one of the requirements in forming a proper 35 U.S.C. 103 (a) rejection, let alone all three, Applicant asserts that *prima facie* obviousness has not been established and the rejection should be withdrawn.

VI. Conclusion

In view of the foregoing remarks, Applicant requests reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 18, 2001

By: 
Louis M. Troilo
Reg. No. 45,284